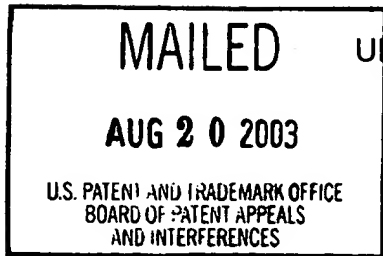


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 38



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERUHISA KAMACHI and TATSUSHI NASHIDA

Application No. 08/939,064

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on August 5, 2003. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

Appellant filed an Information Disclosure Statement (IDS) on February 24, 1999 (Paper No. 9). A review of the application indicates that the IDS was not considered. According to the Manual of Patent Examining Procedure (MPEP) § 609(C)(2) (Eighth Ed., Rev. 1, Feb. 2003):

Examiners must consider all citations submitted in conformance with the rules and this section, and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a form PTO-1449 . . . provides a clear record of which citations have been considered by the Office. . . . Those citations not considered by the examiner will have a line drawn through the citation and any citations considered will have the examiner's initials adjacent thereto . . .

.
 . . . If an item of information in an IDS fails to comply with requirements of 37 CFR 1.197 and 37 CFR 1.198, a line should be drawn through the citation to show that it has not been considered. The other items of information listed that do comply with the requirements of 37 CFR 1.197 and 37 CFR 1.198 will be considered by the examiner and will be appropriately initialed [emphasis added].

It is clear from the record that the IDS (Paper No. 9) was not properly considered by the examiner.

Accordingly, it is

ORDERED that the application is returned to the examiner for proper consideration of the IDS (Paper No. 9) by

(1) initialing all of the references submitted on the (Paper No. 9) PTO Form 1449 to show that they have been considered, and/or by drawing a line through the references not considered,

(2) notifying appellants in writing of consideration of the IDS, and

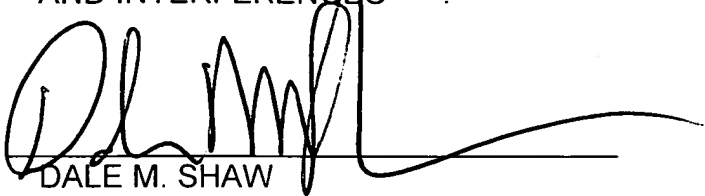
(3) for such further action as may be appropriate.

Application No. 08/939,064

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:

A handwritten signature in black ink, appearing to read 'DMS', is written over a horizontal line.

DALE M. SHAW
Program and Resource Administrator
(703) 308-9797

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DMS/vsh
RA03-0484